

*B<sup>3</sup>*  
cont.

37. A method according to claim 35 wherein said composition is used as a foaming gel for the face.

#### REMARKS

This Amendment is respectfully submitted in response to the Office Action rendered March 18, 2002. The new claims submitted above find basis in original claims 1-17 and in the Specification at page 11, line 10-12. This Amendment is timely in view of the Petition for Extension of Time respectfully submitted herewith.

Applicants respectfully request reconsideration of the rejections and objections set forth in the Office Action of March 18, 2002 in view of the foregoing amendments to the claims and ensuing discussion.

The Office Action of March 18, 2002 objected to the declaration and oath under 37 CFR 1.67 (a) in that it was not dated by the inventors. A new declaration has been sought from the inventors overseas, however; at least one of the inventors has left her employ and is unable to be found. A declaration detailing the inventor's unavailability and applicants' efforts to locate said inventor will be submitted as soon as possible.

The Office Action of March 18, 2002 rejected claims 1-20 under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The grounds for this rejection were that the terms "such as", "in particular for the sensitive parts of the human body" and "glacier SG 809 A" are objectionable. Applicant respectfully requests reconsideration of this rejection in view of the foregoing amendments to the claims and the ensuing discussion.

Claim 1 has been amended to clarify the language referring to the "parts of the human body" and refer instead to human skin. Claims 1 and 4 have been amended to remove the language "in particular". Applicants have also inserted reference in the Specification to the source of Glacier SG 809 A, Quest International, an international fragrance house, from which Glacier SG 809 A is commercially available. No new matter has been added, as it would have been known to those of ordinary skill in the art at the time of the filing of the above-captioned patent application that this fragrance was commercially available. Applicant respectfully submit that the above-mentioned amendments would overcome the rejections set forth in the Office Action and respectfully request their reconsideration.

The Office Action rejected Claims 1-20 under 35 USC 103 (a) as being unpatentable over applicants' "admitted prior art" in view of Koga (JP 10,231,238). The Office Action contends that applicants admit that menthol lactate and menthol "are used in cosmetic and pharmaceutical compositions". [Office Action, p. 4]. The Office Action further sets forth that:

Applicants are also aware that menthol concentrations in compositions at the level (1.25% to 16%) recommended by the Food and Drug Administration (FDA), impart strong flavor and consumers do not appreciate the strong odor and thus such compositions. Applicants are also aware that menthol possess freshening and anti-irritant properties. [Office Action, 3/18/2002, p. 4]

The Office Action also states that Koga teaches a cosmetic composition prepared by adding 0.001 - 10.0 weight percent of menthol and at least one of menthol lactate, menthol glycoside, menthol hydroxybutyrate, methoxypropanediol and menthoxyfurane. The Office Action contends that "one of ordinary skill in the art would know routine procedure for testing different concentrations ratios of menthol and menthol lactate...to provide a composition that is not irritating to the human body." [Office Action, p. 5].

Applicants respectfully request reconsideration of this rejection in view of the ensuing discussion. Applicants respectfully submit that the statements made in their specification would not have lead one of ordinary skill in the art to the compositions of their invention. Although applicants' Specification states that menthol has been used in cosmetic and pharmaceutical products and that the Food and Drug Administration (FDA) requires from 1.25% to 16% menthol, nowhere does the Specification state that menthol lactate and menthol have been utilized together in such compositions in appropriate concentrations and ratios. The Specification merely states as follows:

Menthol is a compound well known to the person skilled in the art for its analgesic, freshening, and odoriferous properties, and it has often been used in cosmetic and pharmaceutical products. [Specification, p. 1, l. 15-18]

However, as set forth in the Specification, "at such concentrations [as recommended by the FDA] the flavor and the odor of the substance are very powerful, and that is poorly appreciated by consumers". [Specification p. 1, l. 24-27]. The Specification also states that "Menthyl lactate has also been used in cosmetic compositions for local application as a freshener". [Specification, p. 2, 29-30].

Thus, the Specification does not admit that it was ever known in the art to utilize menthol and menthyl lactate together, or that they could be used together, in appropriate ratio, to reduce or eliminate strong, objectionable odor associated with menthol. In the context of the compositions of applicants' invention, whether or not menthol exhibits the characteristic of anti-irritation would not have necessarily lead one of ordinary skill in the art to solving one of the problems addressed by the compositions of applicants' invention, i.e., the reduction in odor otherwise brought about by the use of menthol in freshening compositions.

The Office Action proceeds to state that Koga "teaches a cosmetic composition that is prepared by adding 0.001 – 10.0 weight percent of menthol and at least one of menthyl lactate... Applicants are aware that high concentrations of menthol in a composition cause undesired response from consumers. Applicants are aware that menthol possesses anti-irritant properties. Koga... teaches a cosmetic composition comprising lower concentrations of menthol than that recommended by FDA." [Office Action, p. 4]. The Office Action admits that "... the combined teaching of applicants' prior knowledge and Koga does not provide a composition comprising a menthol/menthyl lactate range of from about 1/3 to about 1/10, [but] no unexpected result is presented as to why a composition comprising those particular ranges is critical." [Office Action, pp. 4-5] (emphasis added)

Applicants respectfully request reconsideration of this rejection in view of the remarks herein. Applicants respectfully submit that Koga relates to compositions that "have a refreshing feeling and an excellent capacity for that feeling to be sustained by compounding a refrigerant and then compounding ethanol and isopropyl alcohol with it." [Koga, ¶0003] The means by which Koga achieves its results is by utilizing refrigerants such as menthol or menthyl lactate, but not necessarily both together and not necessarily in such ratios that the serve to achieve the freshening result without an unpleasant odor. Furthermore, Koga teaches that such refrigerants should be used in combination with ethanol and isopropyl alcohol. It neither recognizes nor solves the problem addressed by the compositions of applicants' invention, i.e., that menthol and menthyl lactate may be combined in appropriate weights and ratios to produce refreshment without annoying odor in such compositions. Koga's compositions, where they contain both menthol and menthyl lactate, all contain considerably more menthol than menthyl lactate. Nowhere does Koga teach or suggest the use of menthol and menthyl lactate in ratios wherein there is

considerably less menthol than menthyl lactate (1:3 to 1:10 as opposed to 2:1 or 3:1, as set forth in Koga's Examples). Moreover, while Koga's examples set forth concentrations of menthol that are lower than FDA guidelines, they are still higher than those contemplated by the compositions of applicants' invention (0.2% or 0.3% compared with 0.08% to 0.12%) and menthyl lactate concentrations lower than those of applicants' invention (0.1% compared with 0.45% to 0.55%).

With respect to the Office Action's contention that one of ordinary skill in the art would have known "routine procedure for testing different concentration ratios of menthol and menthyl lactate...to provide a composition that is not irritating to the human body" [Office Action, p. 5], applicants respectfully contend that one of ordinary skill in the art would not have arrived at the claimed compositions on the basis of applicants' statements about menthol and menthyl lactate, in combination with Koga, as set forth in the Office Action. Applicants were guided by their desire not only to achieve a composition that would not affirmatively irritate the skin, but also by the desire to solve the problem generated by odor. Even if the art provided a guide by which to reduce the amount of menthol and/or menthyl lactate in such compositions, there would have been no incentive for those of ordinary skill in the art to seek the appropriate ratios for use in a composition to reduce odor yet provide a refreshing experience for the user.

Moreover, the Office Action's suggestion is more along the lines that it would have been "obvious to try" to make the claimed compositions than one constituting *prima facie* obviousness. One of ordinary skill in the art following Koga would have sought compositions having higher menthol than menthyl lactate concentrations: these may have been less irritating, but may not have necessarily achieved the goal of eliminating or reducing odor. Even on the basis of applicants' comments combined with Koga, there were no directions or suggestions to adjust menthol and menthyl lactate ratios to arrive at the compositions of applicants' invention. Applicants therefore request reconsideration of this rejection based on the foregoing discussion.

The Office Action of March 18, 2002 also rejected claims 1-20 under 35 USC 103(a) as being unpatentable in view of Fowler et al. As set forth in applicants' Amendment of April 19, 2001, Fowler et al. relates to a personal care composition containing insoluble micronized cleansing particles, a water soluble or dispersible gelling agent and water [Fowler et al., col. 2, l. 27-37]. In fact, Fowler et al. merely sets forth a "laundry list" of materials

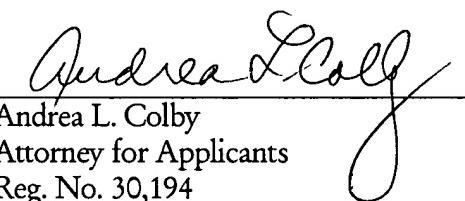
from which menthol or menthyl lactate may be selected without even suggesting that they may or should be used together as a combination [Fowler et al., col. 19, l. 37-43]. Applicants respectfully submit that Fowler et al. mentions literally dozens of compounds that may be present in the described compositions, but it does not recognize or propose compositions that refresh without giving off an overwhelming odor.

Nowhere does Fowler et al. teach or suggest the use of menthol and menthyl lactate in ratios and weights appropriate to achieve the unexpectedly less odiferous compositions of applicants' inventions. Applicants therefore respectfully request reconsideration of this rejection.

Applicants respectfully submit herewith a certified copy of the French patent application from which the above-captioned application claims priority, FR 99 00704 (filed January 22, 1999). Applicants also respectfully submit formal drawings for the above-captioned patent application.

Applicants respectfully request reconsideration of the rejections and objections set forth in the Office Action of March 18, 2002. An early allowance is earnestly solicited.

Respectfully submitted,

  
Andrea L. Colby  
Attorney for Applicants  
Reg. No. 30,194

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, New Jersey 08933-7003  
(732) 524-2792  
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APPENDIX - CLEAN COPY OF AMENDED CLAIMS

*Int'l Spec.*

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1. A freshening cosmetic composition comprising from about 0.01% to about 2% by weight menthol and from about 0.1% to about 10% by weight menthyl lactate, the menthol/menthyl lactate ratio lying in the range from about 1/3 to about 1/10, and being such that the odor of the menthol is barely perceptible, said composition not being irritating to sensitive parts of human skin.

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4. A composition according to claim 1, further comprising a fragrance comprising glacier SG 809A, at a concentration lying in the range from about 0.5% to about 5% by weight of the composition.

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